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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,587	07/14/2001	Edward K. Pavelchek	50161-3C	7910

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EXAMINER

BARRECA, NICOLE M

ART UNIT PAPER NUMBER

1756

DATE MAILED: 07/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/904,587

Applicant(s)

PAVELCHEK ET AL.

Examiner

Nicole M. Barreca

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 14-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                    | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____   |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2,5,6</u> | 6) <input type="checkbox"/> Other:  |

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### DETAILED ACTION

1. Applicant's election of Group I, claims 1-13 in Paper No. 4 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claims 14-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 4.

### *Priority*

3. In the request for a corrected filing receipt submitted 5/12/03, this application claims to be a continuation of Application No. 09/616,851, filed 7/14/2000, now US Patent 6,261,743, which is a continuation of Application No. 08/797,741, filed 2/7/1997, now US Patent 5,939,236. However Application No. 09/616,851 was abandoned. The examiner believes that the intended Application No. 09/058,343, filed on 4/10/1998, which resulted in Patent No. 6,261,743 and is a continuation of Application No. 08/797,741, filed 2/7/1997, now US Patent 5,939,236. For examination purposes, the examiner has assumed that the present application does have the right to priority to both Patent No. 6,261,743 and 5,939,236 and therefore has an effective filing date of 2/7/1997. The examiner request that the applicant correct the priority information in response to this Office Action.

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4. The application also needs reference to the correct parent applications in the first line of the present specification. An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification of in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

5. The phrase "substantially the same" as recited in claim 10 is defined in the applicant's specification on page 7.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 4-9 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Thackeray (US 6,165,697).

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The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Thackeray discloses an antihalation composition which reduces the reflection of exposure radiation of an overlying photoresist layer (i.e. antireflective coating). The antihalation composition comprises a resin binder (applicant's component 1) and material capable of thermally crosslinking reaction, such as an amine based thermal crosslinker (cl.5, 6) (col.3, 43-46). A suitable resin binder includes a polymer comprising anthracene units (cl.4) (col.5, 32-34). The antihalation composition may also comprise an acid or an acid generator, preferably a thermal acid generator (applicant's component 2). A photoacid generator may also be employed (applicant's component 3) (col.6, 11-40). A photoresist is coated over the antihalation layer. Suitable examples of photoresists include chemically amplified positive comprising a photoacid generator and resin binder (cl.9) (col.7, 19-col.8,16). Suitable substrates include those typically used in semiconductor and liquid crystal display manufacturing (cl.13) (col.8, 17-33).

### ***Double Patenting***

8. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

9. Claims 7-13 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-6 of prior U.S. Patent No. 5,939,236. This is a double patenting rejection.

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1, 4-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14-18 and 24 of U.S. Patent No. 6,261,742. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim an

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antireflective composition coated under a photoresist layer, the antireflective composition comprising a resin binder, an acid or thermal acid generator and a photoacid generator.

12. Claims 1, 5, 7, 8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 5 of U.S. Patent No. 6,410,209. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim an antireflective composition coated under a photoresist layer, the antireflective composition comprising a resin binder, an acid or thermal acid generator and a photoacid generator.

13. Claims 1, 5, 7, 8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 13 of copending Application No. 09/918,399. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim an antireflective composition coated under a photoresist layer, the antireflective composition comprising a resin binder, an acid or thermal acid generator and a photoacid generator.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### **Conclusion**

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 2002/0012875 is the Patent Application Publication for the present application. JP 11-133618, published 5/21/99, discloses an

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antireflective composition comprising a resin binder, an acid producing agent or a thermoreactive acid producing agent and a photoreactive acid producing agent.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicole M. Barreca whose telephone number is 703-308-7968. The examiner can normally be reached on Monday-Thursday (8:00 am-6: 30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 703-308-2464. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Nicole Barreca  
Patent Examiner  
Art Unit 1756



July 22, 2003